IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

WRIT PETITION NO. 775 OF 2006

Sardar Gurudas Singh Bedi, an Indian National trading in the name and style of VOLGA CONFECTIONARY WORKS and having its place of business at 16, Municipal Industrial Works, Keshavrao Khadye Marg, Jacob Circle, Mumbai 400 011. ... Petitioner

Vs.

1. Union of India through its Hon'ble Secretary of Ministry of Commerce and industry, under Union Government having its office at Udyog Bhavan, New Delhi.

2. The Registrar of Trade marks, Controller-Generl of Patents, Designs and Trade Marks, Trade Marks Registry also having its office at Old Central Building, C.G.O. Building, 101, Maharshi Karve Road, Mumbai 400 020.

3. The Administrative Officer, Trade Mark Registry having its office at Old C.G.O. Building, 101, Maharshi Karve Road, Mumbai 400 020

4. Rajkumar Basudeo Gupta, an Indian Inhabitant trading as VOLGA ICE CREAM having his address at L Plot No. 44, Section 6, Snapada, Mumbai.

5. Subhash Natha Kunjir also an Indian Inhabitant, trading as VOLGA ICE CREAM having his address at L Plot No. 44, Section No. 6, Snapada, Navi Mumbai.

6. Volga Ice Cream having its place of business at L Plot No. 44, Sector No. 6, Snapada, Navi Mumbai. ... Respondents

Dr. Virendra V. Tulzapurkar, Sr. Counsel with Ms. Rita Vora, i/by Shantilal & Co. for Petitioner.

Mr. Anjali K. Singh with Mr. N.D. Sharma and Mr.

Y.R. Mishra for Respondents 1 to 3.

Mr. T.N. Daruwala, Sr. counsel with Ms. Blossom Noronha i/by Jehangir Gulabhai and Billimoria and Daruwala for Intervener.

CORAM: F.I. REBELLO &
ANOOP. V. MOHTA,JJ.
DATE : 27TH APRIL, 2006

ORAL JUDGMENT (Per F.I. Rebello,J.):

. Rule. Heard forthwith. Respondents 4 to 6 though served, have put in no appearance.

. An application was filed by the Respondent No. 6 for registration of their word mark "Volga Ice cream" and label mark "Volga ice cream". The advertisement was published under Clause (3) in Journal No. 1331 dated 1.6.2006 at Page 1080 by the Registrar of trade marks. It was made available to the public on 4th October, 2005. The stipulated period of time for filing the objection in Form TM 44 was on or before 1.1.2006. The Form TM 44 dated 3.1.2006 was actually presented on 6.1.2006. Respondent Nos. 1 to 3, as TM-44 form was not filed within the period of limitation, refused to accept it. It is this refusal according to the petitioner which has given a cause of action to the Petitioners to file the present petition.

. Section 21 of the Trade Marks Act, 1991,

hereafter referred to as Act, prescribes, the time period for filing Opposition to registration. The express language used in the section, is three months from the date of advertisement or re-advertisement. The section also contemplates that such application also can be considered by the Registrar within such further period not exceeding one month in aggregate on an application made to the Registrar in prescribed manner. The Respondent No. 1 has framed rules which are known as Trade Mark Rules, 2002 which hereinafter shall be referred to as Rules. We are concerned with Rule 47(6). Rule 47(6) literally read enables extension of time for filing application for opposition in Form TM 44 provided the application is made before the expiry of period of three months. The validity of this rule is the subject matter of this petition.

2. With that, a few essential facts :

. Petitioner’s case is that he is in the business as manufacturers and merchants inter alia of confectionery chocolates, toffees, sweet meat, flour and preparations made from cereals and other products and is trading in the name and style of Volga Confectionery Works. The merchandise is sold within the country and even exported outside. In or about 1967, the Petitioner adopted and commenced the

use of trade mark, volga. It is derived from its trading name viz Volga Confectionery works. According to the Petitioner, the Petitioner is the proprietor of the name and mark Volga, on account of his original adoption, long, extensive and continuous use in relation to the said goods. The 4th, 5th and 6th Respondent applied for registration of the mark consisting of the word 'Volga' before the second respondent. The goods of the Petitioner and the 4th, 5th and 6th respondents are similar in nature, so also is the class of purchasers. Instead of opposing, the application for registration, as the Petitioner's application for registration of name and mark was filed on 28th April, 1976 and which was numbered as 313131 and advertised in Trade Mark Journal No. 751 dated 16th September, 1980 at Page No. 581 and which was pending registration, Respondent No. 2 ordered publication of advertisement of the label mark of the 4th, 5th and 6th respondent. Any person desirous of opposing the registration, has to lodge the notice of opposition within the period of three months from the date of advertisement of the application for registration or within such period not exceeding one month in aggregate which the Registrar may grant. The Petitioner on 3.1.2006 came across the advertisement of the label mark Volga Ice Cream and accordingly on the same day, forwarded an application in form TM 44

seeking extension of one months time to file notice of opposition and requested to accept the same. The same was not accepted as set out in Paragraph 6 of the Petition. As the Petitioner's application was not accepted, Petitioner on 5th January contacted his trade mark agent and authorised him to apply for extension of one month. The same was forwarded on 6th January. The Respondent No. 3 endorsed a remark on the covering letter that the application by the Petitioners is time barred and cannot be taken on record. It is the case of the Petitioners that rule 47(6) as framed is ultra vires Section 21 of the Act.

. On behalf of the Respondent Nos. 1 to 3 Mr. Barve, Assistant Registrar of trade marks has filed an affidavit. We will deal only with the essentials in the said affidavit. It is firstly pointed out that the application for registration by the Petitioner in Form TM 44 was treated as abandoned as the same was incomplete having not complied with the procedure of payment of registration fee of Rs.90/- along with Form TM-11 as per the procedure then existing. The Petitioner applied for extension of time for filing the opposition only on 6.1.2006. This is after the period contemplated. In these circumstances, the Petitioner cannot be said to be a person aggrieved, as his application was time

barred. It is admitted that though the mark was published in trade mark Journal dated 1.6.2005, it was made available to members of public only on 4.10.2005. Subsequent thereto, Respondent Nos. 1 to 3 have registered the mark of Respondent No. 6. Based on these facts, the issues in controversy can now be decided.

3. Considering what has been set out, the real controversy which is required to be answered is the scope of rule 47(6). The issue therefore, to be answered now be formulated as under:

> "Is Rule 47(6) of the Rules, ultra vires Section 21 of the Act of 1999?"

4. In order to appreciate the provisions and how the law was earlier stood, we may gainfully refer to the provisions of the previous Acts and rules framed under the respective Acts. The relevant provisions of the Acts and the Rules may now be set out :

Trade Marks Act, 1940.

Section 15(2) Opposition to registration :

> "(2) Any person may, within the prescribed time from the date of the advertisement of

an application, give notice in writing in the prescribed manner to the Registrar of opposition to the registration."

Rules framed under the Trade Mark Rules, 1942 of which Rule 30 read as under :

"Rule 30 - Notice of Opposition - The time within which a notice of opposition to the registration of a trade mark may be given, shall be four months from the date of advertisement of the application for registration."

. Trade and Merchandise Marks Act, 1958:

"Section 21 - Opposition to registration -

(1) any person may, within three months from the date of the advertisement or re-advertisement of an application for registration or within such further period, not exceeding one month in the aggregate, as the Registrar, on application made to him in the prescribed manner and on payment of the prescribed fee, allows, give notice in writing in the prescribed manner to the Registrar, of opposition to the

registration."

We then refer to Trade and Merchandise Rules, 1959. Rule 51 which read as under :

"Rule 51 - Notice of Opposition (1) A notice of opposition to the registration of a trade mark under sub section (1) of Section 21 shall be given in triplicate on Form TM-5 within there months from the date of the advertisement or re-advertisement, as the case may be, of the application for registration in the Journal. the notice shall include a statement of the grounds upon which the opponent objects to the registration. If the registration is opposed on the ground that the trade mark in question resembles marks already on the register, the registration numbers of such trade marks and the dates of the journals in which they have been advertised shall be set out.

(2) An application for an extension of the period within which a notice of opposition to the registration of a trade mark may be given, shall be made on Form TM-44 accompanied by the prescribed fee. Such

period of extension shall not exceed one month in the aggregate.

(3) The request fore extension of time under sub rule (2) shall be made to the Registrar before the expiry of three months from the date of advertisement or readvertisement of the application for registration in the Journal."

Rule 51(3) was omitted by Notification No. S.O. 397 dated 23rd January, 1969.

Trade Marks Act, 1999.

Section 21 of the Trade Marks Act, 1999 reads as under :

"Opposition to registration : (1) any person may, within three months from the date of the advertisement or re-advertisment of an application for registration or within such further period, not exceeding one month in the aggregate, as the Registrar, on application made to him in the prescribed manner and on payment of the prescribed fee, allows give notice in writing in the prescribed manner to the Registrar, of

opposition to the registration."

. Rule 47(2) of the Trade Mark Rules, 2002 reads as under :

"Rule 47(1) : A notice of opposition to the registration of a trade mark under sub section (1) of Section 21 shall be given in triplicate in Form TM-5 within three months or within such further period not exceeding one month in the aggregate from the date the journal is made available to the Public (which date shall be certified by the Registrar as such). The notice shall include a statement of the grounds upon the opponent objects to the registration. If the registration is opposed on the ground that the trade marks in question resembles marks already on the register, the registration numbers of such trade marks and the dates of the Journals in which they have been advertised shall be set out. "

Rule 47(6) of the Trade Marks Rules, 2002 reads as under :

"An application for an extension of the period within which a notice of opposition

> to the registration of a trade mark may be given under Sub section (1) of section 21, shall be made in Form TM-44 accompanied by the free prescribed in first Schedule before the expiry of the period of three months under sub section of section 21. "

5. If the Act of 1940 is seen, the period for filing notice for opposition was four months from the date of advertisement of application for registration. There was no provision provided for extension of time beyond four months. However, in the Act of 1958, the period for filing opposition was reduced to 3 months but a discretion was conferred on the Registrar in terms of Rule 51(3) of the 1959 rules to grant an extension of one month in the aggregate. When the rules were framed, Rule 51(3) was couched in similar language as present Rule 47(6).

. In so far as Section 21 of the Act of 1958 is concerned, the language uses similar phraseology as Section 21 of the Act of 1999. Rule 51(3) of the Trade and Merchandise Rules, 1959 provided that request for extension of time in sub rule (2) shall be made to registrar before the expiry of three months from the date of advertisement or

re-advertisement of the application for registration in the journal. This sub rule was omitted by notification No. S.D. 397 dated 23rd January, 1969. We then have the trade marks Rules of 2002 and the relevant rule is 47(6). Though the language may not be exactly as in Rule 51(3) of the Rules of 1959, yet Rule 47(6) like Rule 51(3) before its omission, contemplated that the application for extension of time must be made before the expiry of the period of three months under Section 21.

. A reading of Section 21 as reproduced earlier, nowhere sets out that the application for extension of time has to be made before the expiry of period of three months for filing opposition to the registration. The question then, that we have been called upon to answer is whether Rule 47(6) is ultra vires of Section 21 of the Trade Marks Act, 1999. The primary object of enacting Section 21 is to effect registration at the earliest and therefore, only those objections which are filed within the period as stipulated, should be considered. Unlike the Act of 1940, which provided for four months period, the Act of 1959 provided only for three months period with a power in the Registrar to grant time not exceeding one month in the aggregate. The time however, for filing objection under the Act of 1958 which was reduced to three months has been

maintained in the Act of 1999. A power has however, been conferred on the Registrar to extend the period of filing opposition by a period not exceeding one month in the aggregate.

6. The object of filing opposition is to maintain the purity of the register. This court in Ciba Limited Vs. M. Ramalingam, 49 B.L.R. Page 548, speaking through Chagla, J. observed as under :

> "Now, in considering both s. 46 and s. 10, it has got to be remembered that the primary duty of the Court is towards the public and the maintenance of the purity of the register. When a case is sought to be made out that a particular trade mark is likely to deceive or cause confusion, the contest is not so much between the parties to the litigation as it is a contest between the party defending his right to a particular trade mark and the public, an the duty of the Court must always be to protect the public irrespective of hat hardship or inconvenience it may cause to a particular party whose trade mark is likely to deceive or cause confusion. The object of maintaining a trade mark register is that the public should know whose goods they are

> buying and with whom particular goods are associated. It is, therefore, essential that the register should not contain trade marks which are identical or which so closely resemble each other that an unwary purchaser may be likely to be deceived by thinking that he is buying the goods of a particular person or a particular firm or a particular industry, whereas he is buying the goods of another person or firm or industry. "

. Is Rule 47(6) as now framed, in consonance with Section 21 of the Act, and if not, is it ultra vires Section 21 of the 1959 Act. Section 21 of the Act states that any person may, within three months from the date of the advertisement or re-advertisement of an application for registration or within such further period, not exceeding one month in the aggregate, as the Registrar, on application made to him in the prescribed manner and on payment of the proscribed fee, allows, give notice in writing in the prescribed manner to the Registrar, of opposition to the registration. Rule 47(6) provides that this application for extension must be done before the expiry of the period of three months. In other words, what the rule contemplates is jurisdiction in the Registrar to extend time by

exercise of discretion, only if it is made before the expiry of three months period. The rule as read, confers no discretion in the Registrar to accept objections filed, if the period of there months has expired. In Mahanth Ram Das. Vs. Ganga Das, A.I.R. 1982 S.C. 887, the issue before the Apex court was the power to extend time where the time extended to do particular act had expired. In that case, the High Court had set time for payment of court fees. The fees could not be paid within the period stipulated. Even though an application was made for extension of time before the time had run out, it was not considered and as on the date of hearing, the appeal period had expired. The Apex Court on the facts of that case was pleased to observe as under :

> "How undesirable it is to fix time peremptorily for a future happening which leaves the Court powerless to deal with events that might arise in between, it is not necessary to decide in this appeal....."

In Kantilal Tukidas Jobanputra Vs. The Registrar of Trade Marks and Lion Pencils Pvt. Ltd. in Misc. Petition No. 926 of 1977 and Misc. Petition No.

1511 of 1977, in consideration, was Rule 53 of the Trade and Merchandise Marks Rules, 1959. A Notice of Opposition was filed by the Petitioner there in the matter of application for registration of the mark. There was some dispute as to the person entitled to file opposition. In the meanwhile the period for filing evidence in support of opposition had expired and the Registrar of Trade Marks directed that the opposition be deemed to be abandoned by virtue of Rule 53 of the 1959 Rules. An application for review as filed, was rejected. A learned Single Judge of this Court considering Rule 53, was pleased to hold firstly that rule was directory and not mandatory and secondly, the Registrar's power to extend time for filing evidence in support of possession does not stand extinguished, if the application for extension of time was not filed or extension was not granted before the expiry of period of two months prescribed by Rule 53(1) and thirdly the court held, that Rules or procedure before any Tribunal were for advancement of the cause of justice and not to close the doors, thus preventing the parties to get determination on merits. It is not necessary to advert to other findings. This interpretation of Rule 53 also came up for consideration before a Full Bench of Delhi High Court in Hastimal Jain Trading as Oswal Industries Vs. Registrar of Trade Marks

and Anr. 2000 PTC 24 (FB). The Full Bench of the Delhi High Court was pleased to hold that Rule 53 is directory and enables the Registrar to extend time, even though the time has expired. Dealing with the issue that procedural law is meant to advance the cause of justice, we may quote from the observations of the Apex Court in State of Punjab and another Vs. Shamlal Murari and another, AIR 1976 S.C. 1977. The Apex Court in the matter of procedural law was pleased to observe as under :

> "We must always remember that processual law is not to be a tyrant but a servant not an obstruction but an aid to justice. It has been wisely observed that procedural prescriptions are the hand-maid and not the mistress, a lubricant, not a resistant in the administration of justice. Where the non-compliance, tho' procedural, will thwart fair hearing or prejudice doing of justice to parties, the rule is mandatory. But grammar apart, if the breach can be corrected without injury to a just disposal of the case. We should not enthrone a regulatory requirement into a dominant disderatum.After all, Courts are to do justice, not to wreck this end product on technicalities. Viewed in this perspective,

> even what is regarded as mandatory traditionally may, perhaps, have to be moderated into wholesome directions to be complied with in time or in extended time."

7. The Law is now well settled, that a rule cannot travel beyond the scope of the Parent Act. If authorities are needed, we may refer to the case of Laghu Udyog Bharati And another Vs. Union of India and Others, (1999) 6 Supreme court Cases 418, wherein the Apex Court observed :

> "The rules, therefore, cannot be so framed which do not carry out the purpose of the chapter and cannot be in conflict with the same."

Similar view is taken in Additional District Magistrate (Rev) Delhi Admn. Versus Sheo Ram and Others, (2000) 5 Supreme Court Cases 451. The Apex Court observed as under :

> "It is a well-recognised principle of interpretation of a statute that conferment of rule-making power by an Act does not enable the rule-making authority to make a rule which travels beyond the scope of the

> enabling Act or which is inconsistent therewith or repugnant thereto. From the above discussion, we have no hesitation to hold that by amending the Rules and Form P-5, the rule-making authority has exceeded the power conferred on it by the Land Reforms Act. "

. From what we have discussed above, the conclusion which emerges is that in matters of procedural law courts should normally read the provisions as directory and the rule should sub serve the object of the Act and not defeat it or in other words be in conflict and travel beyond the scope of the enabling Act. In an exercise in subordinate legislation, it is not open to the delegate conferred with power to make subordinate legislation, to make a rule which would be inconsistent or contrary to the provisions of the principal Act itself. If there be a purported conflict in interpretation, to save the rule it is, possible for the court to read down the rule to make it in conformity with the provisions of the substantive law. Bearing this principle in mind, let us consider the issue as framed. Is Rule 47ˆ6) in conformity with Section 21 and if it be in conflict, whether it can be read down to make it in conformity with the mandate of section 21.

8. The power conferred to file opposition to registration is not merely to the person who is the proprietor of the mark or claims interest in the mark. The expression "any person" has to be given a wider meaning. As the object of the opposition is to maintain the purity of the register, Shavaksha in ‘The Trade and Merchandise Marks Act, 1958’, Third edition, has observed as under :

> "The object of maintaining a trade mark register is that the public show know whose gods they are buying and with whom the particular goods are association. It is, therefore, essential that the register should not contain trade marks which are identical, or which so closely resemble each other, than an unwary purchaser may be likely to be deceived into thinking that he is buying the goods of a particular person whereas he is inf act buying goods of another."

. It is therefore, essential that the register should not contain any trade mark which is identical or which so closely resembles to each other, that the common purchaser may be likely to be deceived by

believing that he is buying the goods of particular person whereas he is in fact buying the goods of another person. That being the object, the court while interpreting the provisions must bear that in mind so as to maintain the purity of the Register.

. The expression "any person" would have to be given wider meaning to include even a consumer and not necessarily the proprietor or person having interest in the mark. If this is so understood, then the object behind section 21 manifests itself. The ordinary period for a person to file an objection would be three months. The period for extension of time on reading of Section 21 of the Act could be before the expiry of the period of three months or can be even after the expiry of three months. At the first blush considering the expression "within such further period" it would appear that granting extension of time of one month in aggregate can only be before the expiry of the period. If it is so read, then the time to file objection will have to be before the expiry of three months and the discretion in the Registrar to extend time is only before the expiry of three months. The rule as framed, if the construction is accepted, will be intra vires section 21. The rule so read would mean that only a class of persons who had knowledge or were vigilant of the publication before

the expiry of the period of three months, can alone apply for extension. The other class of persons whose attention is drawn after the expiry of three months, even by a day or though aware for reasons beyond their control, will be barred from filing their opposition, however sufficient their cause. Rule 47(6) as now framed is couched in the same language as Rule 51(3) under the Rules of 1959. The said rule was omitted by S.O. 397 dated 23rd July, 1969. In other words, the delegate entrusted to make the rules, itself found that the rule was acting harshly and or oppressive and not in conformity with the object of the Act. The language of section 21 in the Act of 1958 and Act of 1999 is substantially the same. If that be the position, the question is, what is that made the delegate frame a rule similar in language to a rule which was omitted. No explanation has come from the Respondents. The section uses the word three months and such further time of one month. That period can also be beyond three months. It would therefore, have to be held, that the power in the Registrar to extend the period, can be before the period of three months has expired, as also even after the period of three months has expired. In such event, the expression one month in aggregate will have to be read to mean also on the expiry of the period of three months. The discretion in the registrar

therefore, to extend the time would also be on the expiry of the period of three months. It is not as if the Registrar is bound to give a period of one month. It is open to the Registrar considering the facts of the matter, to give such additional period and if discretion is to be exercised to extend time, then to grant such time, so that it does not exceed in the aggregate one month. This is how the delegate, understood the law when Rule 56(3) was omitted in 1969, in the rules of 1959. The period of one month in aggregate therefore, in Section 21, will have to be read to mean aggregate of one month even on the expiry of the period of three months.

. If rule 47(6) as it now stands has to be accepted, then it confers power to extend time only if the application is made before the expiry of period of three months. Such a rule will be clearly ultra vires Section 21(1) of the Act of 1999. It is also not possible to read down Rule 47(6) so as to make the rule intra vires section 21. Nothing also has been brought before us to point out any mischief that was being occasioned and which mischief was required to be remedied. In the Act of 1940, Section 15(2), did not set out the period, but left it to the rule making authority. The Rule making authority, provided a period of four months to file opposition. Under the Act of 1958, the period was

fixed by the Legislature itself, though the delegate made rules in an exercise of subordinate legislation. The same is the position in the Act of 1999. In these circumstances, we are clearly of the view that Rule 47(6) is clearly ultra vires of Section 21 of the Act and consequently will have to be struck down as null and void.

9. Once that be the case, the impugned order is liable to be set aside. Considering the peculiar facts, we allow the application but we grant time of 15 days from 31.07.2006 to enable the Petitioner to file his opposition to registration, if such opposition has not been filed. The Respondent No. 2 then to consider the same and dispose if off according to Law.

. In the light of the above, Petition made absolute in terms of Prayer Clauses (a), (b), (c), (d) and (e).

(ANOOP V. MOHTA,J.) **(F.I.REBELLO, J.)**